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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA,
SAN FRANCISCO DIVISION

SONOS, INC.,
Plaintiff and Counter-defendant,
v.
GOOGLE LLC,
Defendant and Counter-claimant.

Case No. 3:20-cv-06754-WHA
Related to Case No. 3:21-cv-07559-WHA

**SONOS, INC.'S MOTION *IN LIMINE*
NO. 3 TO EXCLUDE INVALIDITY
BASED ON LACK OF WRITTEN
DESCRIPTION OR ENABLEMENT
FOR THE '885 AND '966 PATENTS**

Judge: Hon. William Alsup
Pretrial Conf.: May 3, 2023
Time: 12:00 p.m.
Courtroom: 12, 19th Floor
Trial Date: May 8, 2023

NOTICE OF MOTION

TO ALL PARTIES AND THEIR ATTORNEYS:

PLEASE TAKE NOTICE that on May 3, 2023 at 12:00 p.m., or as soon thereafter as may be heard before the Honorable Judge William H. Alsup, in Courtroom 12 on the 19th Floor of the United States District Court for the Northern District of California, San Francisco Courthouse, 450 Golden Gate Avenue, San Francisco, CA 94102, Sonos, Inc. (“Sonos”) will, and hereby does, move this Court to preclude argument, evidence, or references that the ’885 and ’966 patents are invalid for lack of written description or enablement under 35 U.S.C. § 112. This motion is based on this Notice of Motion and Motion, the accompanying Memorandum of Points and Authorities, the Declaration of Joseph R. Kolker (“Kolker Decl.”), all exhibits filed herewith, all documents in the Court’s file, and such other written or oral evidence and argument as may be presented at or before the time this motion is heard by the Court.

STATEMENT OF THE RELIEF REQUESTED

Sonos requests that this Court exclude any argument, evidence, or references that the ’885 and ’966 patents are invalid for lack of written description or enablement.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Google should not be permitted to present evidence or argument that the '885 and '966 patents are invalid for lack of enablement or written description. The Court granted summary judgment on Google's written description challenge to the '885 patent. Google did not provide any expert opinion that the '966 patent—which has the same specification as the '885 patent and the same relevant claim language—is invalid for lack of written description. Together with the prior summary judgment ruling, Google therefore has no basis for presenting a written description challenge to the '966 patent at trial. Meanwhile, Google has provided no expert opinion that either patent is invalid for lack of enablement. Accordingly, at trial, Google should be precluded from making any argument, introducing any evidence, or making any references whether the '885 and '966 patents meet the written description and enablement requirements of § 112, including any argument that if the '885 and '966 patents are enabled, the prior art must be as well.

II. STATEMENT OF RELEVANT FACTS

Sonos asserts that Google directly and indirectly infringes two patents: U.S. Patent No. 10,848,885 (“the '885 patent”) and U.S. Patent No. 10,469,966 (“the '966 patent”). The '885 and '966 patents are referred to as the “Zone Scenes” patents. They share the same specification and both claim aspects of Sonos's zone scenes technology.

As relevant here, at the showdown summary judgment stage, the Court concluded that certain Google products infringe the '885 patent, and the Court rejected Google's written description challenge to the '885 patent. Dkt. 309 at 14-17.

At the very early stages of this case, Google asserted § 112-based invalidity claims with respect to both the '966 and '885 patents. *See* Kolker Decl. Ex. A at 18-21, 25-28. Google contended that both the '966 and '885 patent claims “may fail to satisfy the requirements of §112, ¶ 1 because the specification and original patent application fail to provide an enabling disclosure of and written description support for” certain claim limitations and terms. *Id.* at 19-20, 26.

At the showdown summary judgment stage, Google moved for summary judgment of

1 invalidity of claim 1 of the '885 patent, contending that the patent's "claimed set of operations"
2 lacked written description support. Dkt. 247-3 at 18-25.

3 The Court considered and rejected Google's argument. First, the Court rejected Google's
4 specific argument "that the specification 'never discloses that a zone player may be added to two
5 zone scenes at the same time,'" noting that Figure 5B of the specification and other disclosures in
6 the specification "adequately convey that a zone player can be added to multiple zone scenes."
7 Dkt. 309 at 14-15. Second, the Court rejected Google's contention "that the specification does
8 not provide support for the zone player 'continuing to operate in the standalone mode until a
9 given one of the first and second zone scenes has been selected for invocation' and 'transitioning
10 from operating in the standalone mode to operating in accordance with the given one of the first
11 and second predefined groupings of zone players.'" *Id.* at 15. The Court noted that while
12 "Google repeatedly points out [that] the specification never expressly refers to the term
13 'standalone mode,'" "the specification does not have to use the term verbatim to provide
14 sufficient disclosure," and it "does so here." *Id.* at 16-17.

15 With Google's leading § 112 argument removed from play, Google stopped pursuing
16 written description or enablement challenges to the '885 or '966 patents. Google's remaining
17 invalidity challenges to these zone scene patents are all laid out in the opening expert report of
18 Google's technical expert, Dr. Schonfeld. *See* Kolker Decl. Ex. B at i-ix. Dr. Schonfeld contends
19 that both patents are invalid based on alleged prior art, but offers no opinion on any written
20 description or enablement challenges. *Id.* And Google's pending motion for summary judgment,
21 like Dr. Schonfeld's invalidity report, asserts only prior art-based invalidity claims with respect to
22 the '885 and '966 patents. *See* Dkt. 483 at i-ii.

23 As relevant here, Google contends that the combination of the Sonos 2005 system and
24 Sonos Forum posts render the asserted claims of the '885 and '966 patents obvious. *See id.* at 18-
25 20. In opposition, Sonos explains, among other things, that nothing in these asserted references
26 teach "a person of ordinary skill in the art how to implement the claimed 'zone scene'
27 technology," and the "Sonos Forum posts express a mere hope that Sonos would one day invent
28

1 technology that allowed users to have ‘virtual zones,’ without providing any direction, guidance,
 2 or working examples of how to carry out the invention.” Dkt. 508 at 18. For these as well as
 3 other reasons, Sonos explains that Google’s asserted prior art fails to teach the challenged claim
 4 limitations and also fails to enable the claimed invention. *See id.* at 17-18.

5 In the face of Sonos’s proffered evidence showing lack of enablement by the prior art,
 6 Google pivoted, and argued that the *patent* claims are pitched at the same level of generality as
 7 the prior art, which was somehow a flaw in Sonos’s response to Google’s invalidity arguments:

8 Sonos argues that the combination of the Sonos Forums and Sonos 2005 system
 9 would not “enable a skilled artisan to make and use the claimed invention” because
 10 they do not teach “critical details” such as the “programming” for how the speakers
 11 would interact with a controller, how the speakers would operate, and how they
 12 would be commanded to play back music.[] Opp. at 17-18. But, critically, the patent
 13 claims also do not recite any of these “details” or “programming.”

14 Dkt. 538 at 10. At oral argument, Google leaned into this position, defending its “obviousness
 15 case” by pointing the Court back to its prior “ruling on written description,” Ex. C at 60:9-14, in
 16 which the Court held that that the specification underlying the ’885 patent provided adequate
 17 written description support for claim 1 of that patent, Dkt. 309 at 14-17. Summarizing Google’s
 18 argument, the Court asked:

19 But on that last point, I’m asking this question. If the specification, itself, does not
 20 elaborate on how to save [speaker groups], can we take that under the case -- does
 21 the case law say we can take that as an admission against interest to the patentholder
 22 that anybody skilled in the art would know how to do it?

23 Ex. C at 66:19-24. Counsel for Google responded “[y]es, Your Honor,” and contended that
 24 support for this proposition could be found in “the *KSR* case.” *Id.* at 66:25-67:4.

25 Google similarly defended its obviousness case—and its contention that the prior art is
 26 enabling—by arguing the *specification* underlying the ’885 patent lacks explicit references to the
 27 claimed “indication” that a speaker has been added to a speaker group: “Just like with saving,
 28 Your Honor, you can look through the entire patent, and you won’t even see any algorithms or
 any specific messages on this indication. The only time the word ‘indication’ ever shows up is in

the patent *claim*.” *Id.* at 76:5-9 (emphasis added).¹ As Sonos noted, Google was improperly comparing the *specification* and the prior art, when the proper comparison is “what is in the claims” of the asserted patents against the prior art. *Id.* at 76:12-15.

III. ARGUMENT

Because Google has no remaining claims for invalidity of the ’885 or ’966 patents based on any alleged lack of adequate written description or enablement, Google should be precluded at trial from making any argument, introducing any evidence, or making any references to written description or enablement challenges for the ’885 and ’966 patents, including any argument that if the ’885 and ’966 patents are enabled, the prior art must be as well.

A. Google Should Be Precluded From Raising Undisclosed Invalidity Defenses

Because Google’s expert opinion regarding written description was rejected during the showdown, and because Google has not offered any expert opinion in support of written description or enablement invalidity claims with respect to the ’885 and ’966 patents for the upcoming trial, Google should be precluded from making any argument or reference to alleged lack of written description support or enablement of the asserted claims of the ’885 and ’966 patents. *See, e.g., Goodman v. Staples The Office Superstore, LLC*, 644 F.3d 817, 827 (9th Cir. 2011) (Rule 37 “forbid[s] the use at trial of any information that is not properly disclosed.”). Dr. Schonfeld’s expert report regarding the alleged invalidity of the ’885 and ’966 patents makes no mention of such theories, so the Court should “preclud[e] him from testifying on this issue.” *Nationwide Transp. Fin. v. Cass Info. Sys., Inc.*, 523 F.3d 1051, 1062 (9th Cir. 2008). As this Court requires, “at trial, the direct testimony of experts will be limited to the matters disclosed in their reports.” *Guidelines for Trial and Final Pretrial Conference in Civil Jury Cases Before the Honorable William Alsup* ¶ 15.

Accordingly, Google should be precluded from offering any opinion on whether the asserted claims of the ’885 or ’966 patents have insufficient disclosure in the specification.

¹ *See, e.g., Kolker Decl. Ex. C* at 83:1-3 (“And again, we didn’t hear anything from counsel about any additional disclosure [by the specification] of saving. No disclosure [by the specification] of how to send indications.”).

1 **B. Google Should Be Precluded From Arguing Or Suggesting That The Alleged**
2 **Prior Art Is Enabled Through Comparisons To The '885 or '966 Patents, Or**
3 **Vice Versa.**

4 As explained above, Google is asserting prior-art based invalidity arguments against the
5 '885 and '966 patents. As part of that argument, Google contends that the prior art's disclosure is
6 co-extensive with the shared specification of the '885 and '966 patents. So, according to Google,
7 if the '885 and '966 patents meet the requirements of § 112, so too must its prior art combination
8 be enabled. Google's argument lacks merit and is highly likely to confuse the jury.

9 First, there is no support for Google's argument that it can show the prior art is enabled by
10 comparing the prior art to the disclosure in the patent. When asked whether "the case law say[s]
11 we can take that as an admission against interest to the patentholder that anybody skilled in the art
12 would know how to do it?," Ex. C at 66:19-67:4, Google pointed the Court to a passage in *KSR*
13 discussing an "obvious to try" scenario for showing motivation to combine:

14 Third, the court erred in concluding that a patent claim cannot be proved obvious
15 merely by showing that the combination of elements was obvious to try. When there
16 is a design need or market pressure to solve a problem and there are a finite number
17 of identified, predictable solutions, a person of ordinary skill in the art has good
18 reason to pursue the known options within his or her technical grasp. If this leads to
19 the anticipated success, it is likely the product not of innovation but of ordinary skill
20 and common sense.

21 *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 402-03 (2007); Ex. C at 83:4-22 (quoting same).

22 The Supreme Court said nothing about using the *specification's* purported lack of
23 disclosure to show that the prior art was enabling. Nor would such a comparison make any sense.
24 Enablement requires looking to the disclosure at issue—not comparing and contrasting the
25 challenged disclosure to some other document. *See, e.g., Liebel-Flarsheim Co. v. Medrad, Inc.*,
26 481 F.3d 1371, 1378 (Fed. Cir. 2007) ("We have stated that the 'enablement requirement is
27 satisfied when one skilled in the art, *after reading the specification*, could practice the claimed
28 invention without undue experimentation.'" (emphasis added) (citation omitted)). The '885
patent's specification simply cannot be used to show that the prior art is enabling, nor would there
be any problem with a fact-finder determining that the prior art was not enabling but the '885
patent was enabling. First, the Sonos Forums prior art consists of a few paragraphs of hopeful

1 wishes by users. The '885 patent's specification, in contrast, contains 11 columns of detailed
2 description of the invention and 6 figures illustrating the invention. It would be entirely
3 consistent to reach different conclusions based on those different disclosures.

4 Second, it is Google's burden to show invalidity by clear and convincing evidence. For
5 example, in this case, it would be Google's burden to show lack of written description support or
6 lack of enablement of the '885 and '966 patents by clear and convincing evidence, and it is *also*
7 Google's burden to show obviousness by clear and convincing evidence. 35 U.S.C. § 282(a).
8 And Google cannot establish obviousness unless the claimed prior art would enable the claimed
9 invention. *See Raytheon Techs. Corp. v. Gen. Elec. Co.*, 993 F.3d 1374, 1376-77, 1379-82 (Fed.
10 Cir. 2021); *Geo. M. Martin Co. v. All. Mach. Sys. Int'l LLC*, 618 F.3d 1294, 1303 (Fed. Cir.
11 2010); *Minn. Min. & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1306 (Fed. Cir. 2002). Google
12 could quite easily fail to meet that burden as to both obviousness and enablement (assuming any
13 enablement issue was even on the table here). So Google's suggestion that if it loses on
14 enablement, it has to win on obviousness is logically flawed. Because Google is wrong on the
15 law, its "comparison" evidence lacks any relevance and should be excluded under Rule 401.

16 Third, Google should be precluded from making any reference to written description or
17 enablement in the context of the '885 or '966 patents because any "probative value is
18 substantially outweighed by a danger of" "unfair prejudice, confusing the issues, misleading the
19 jury, undue delay, [or] wasting time." Fed. R. Evid. 403. If Google injects § 112 arguments
20 against the '885 and '966 patents, the jury may be confused and wrongly conclude that § 112
21 challenges are on the table and that they should decide or consider those issues in the context of
22 infringement or validity. A curative jury instruction would be necessary, but not sufficient, and
23 Sonos would be forced to spend limited trial time establishing to the jury something that has
24 already been established in this litigation: that claim 1 of the '885 patent has adequate written
25 description support, and that because Google does not contend that the asserted claims of the '885
26 and '966 patents otherwise lack written description support or enablement, the presumption of
27 validity means that the jury *cannot* consider whether either patent is invalid on these bases.

1 **IV. CONCLUSION**

2 For the foregoing reasons, the Court should grant Sonos, Inc.'s Motion *in Limine* to
3 preclude any argument, evidence, or references to alleged § 112 bases for invalidity of the '885
4 and '966 patents, including any argument that if the '885 and '966 patents are enabled, the prior
5 art must be as well.

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7 Dated: April 13, 2023

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11 *Attorneys for Sonos, Inc.*
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